## REMARKS

Claims 44-91 are pending in the application. By this Preliminary Amendment claims 87 and 88 have been amended and claims 92-96 have been added.

The Preliminary Amendment is being filed with a Request for Continued Examination. This Preliminary Amendment addresses the After Final Rejection dated July 5, 2001.

Applicant appreciates the courtesies extended by Examiner Huynh and Examiner Rada to Applicant's representatives during a personal interview conducted on December 4, 2001. The substance of the personal interview is discussed below.

With respect to the objection of claims 87 and 88, these claims have been rewritten in independent form in order to overcome the objection. Withdrawal of this objection is respectfully requested.

With respect to the rejection of claims 44, 56-57, 61-64, 74-76 and 81-91 under 35 U.S.C. §103(a) over Kubacki et al., U.S. Patent No. 4,476,781, in view of Carlson, U.S. Patent No. 4,375,025, Applicant has the following remarks.

At the outset, Applicant notes that this rejection is essentially a repeat of the §103(a) rejection in the May 4, 2000 Office Action, wherein claims were rejected over Atkinson in view of Kubacki. Kubacki discloses a system in which indicia is stamped into intermittently fed sheet metal subsequently used in the production of tabs of aluminum cans. For the purposes of the rejections, Atkinson and Carlson disclose essentially the same thing - a laser that provides laser engravings during constant movement of a strip. In Carlson, the laser engravings are provided to mark an electrical component attached to a strip, and Atkinson teaches providing a laser engraving in a longitudinal direction of a continuous metal strip. The Atkinson/Kubacki rejection was withdrawn for at least the reasons noted in the

Amendment filed on November 6, 2000. The Carlson/Kubacki rejection should be withdrawn for similar reasons.

Specifically, claim 44 is directed to a method of manufacturing articles to be included in cans. The method includes intermittently feeding a metal strip having an upper surface and a lower surface into an article forming unit and providing at least one of the upper surface and the lower surface of the strip with laser engravings from a laser unit when the strip is in an immobilized condition and before the strip is fed into the article forming unit where the articles are formed. The laser engravings form marks on at least one of the upper surface and the lower surface of the strip.

Kubacki and Carlson do not teach or suggest the features as recited in claim 44. In the Office Action, it is conceded that Kubacki does not teach laser engraving during an immobilized condition of the strip. Instead, Kubacki discloses a system in which indicia is stamped into sheet metal. This is the prior art discussed in Applicant's application. See pages 2 and 3. To make up for this deficiency, the Office Action relies on Carlson to teach the marking being provided from a laser unit. However, Kubacki and Carlson are directed to non-analogous arts because 1) they are not from the same field of endeavor, and 2) they are not directed to solving the problems that are solved by the present Applicant. See In re Oetiker, 977 F.2d 1443, 1444, 24 USPQ2d 1443, 1145-46 (Fed. Cir. 1992) ("In order to rely on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned"). As to point 1) Kubacki is directed to the field of stamping tabs for beverage cans during an immobilized condition of a strip, whereas Carlson is directed to the field of laser engraving electrical components that are continuously fed along a side of a strip carrier. As to point 2) neither Kubacki nor Carlson are directed to solving problems associated with providing a laser engraving on a tab or strip

during a period when the tab or strip is immobilized. It was Applicant who discovered how to apply a laser engraving process to an intermittently fed metal strip used for tabs for making beverage cans. See page 3, line 26 to page 4, line 29 and page 8, lines 6-32. "The requirements on the laser unit are high in the sense that the laser engraved marks must be provided in an extremely short time due to the high feeding rate of the strip. The laser radiation also has to be very accurate positioned on the strip, since the tab surface available for the markings is very small."

Further, Carlson and Kubacki are not combinable because they are drawn to mutually exclusive structures. Carlson discusses a system for marking continuously moving electrical components and Kubacki teaches stamping beverage cans during an immobilized condition. According to Carlson, strips having electronic components mounted thereon are driven through an electronic eye that detects the leading edge of the electrical component and gives the laser a signal to fire (column 2, lines 39-45). This points away from the subject matter of claim 44, which relates to intermittent strip processing. Moreover, Kubacki and Carlson could not have been combined without the benefit of Applicant's disclosure and impermissible hindsight. See Grain Processing Corp. v American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("It is impermissible to use the applicant's disclosure as a bluprint to reconstruct the claimed invention out of isolated teachings in the prior art"). There is no motivation for "picking" and "choosing" among the various elements of Carlson and Kubacki, to the exclusion of other elements, to arrive at the claimed combination. See In re Kamm, 172 USPQ 298, 301, 302 (CCPA 1972) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art").

Moreover, the system in Carlson cannot be operated when the strip is in an immobilized condition. The system of Carlson comprises a photoelectric eye that detects the leading edge of the electric component as the electric component is driven thereby and gives the laser a firing signal (column 2, lines 39-45). Thus, if the strip is not continuously moving past the electric eye to intercept the light beam to trigger the laser, the laser will not fire. As a result, the laser of Carlson cannot be applied to a system that is intermittently fed, like the system of Kubacki. See Ex parte Hartmann, 186 USPQ 366, 367 (Bd. App. 1974). Carlson does not teach one of ordinary skill in the art how to apply a laser to an intermittently fed strip. Kubacki's system would be destroyed if converted to a continuously fed strip, as taught by Carlson because the nature of Kubacki's system requires intermittent feeding.

Also, Kubacki does not disclose the use of a laser for engraving, and was not aware of the problems associated with laser engraving for an intermittently fed strip. Applicant discovered how to apply a laser to an intermittently fed strip used to make beverage cans. See page 3, line 26 to page 4, line 29 and page 8, lines 6-32.

Claims 56-62 are allowable by virtue of their dependence on claim 44, and for their recitation of additional patentable subject matter.

Finally, independent claims 63, 83, and 87-91 were also rejected under the Carlson/Kubacki combination. Because Carlson and Kubacki are from non-analogous arts and they are not otherwise combinable without the use of impermissible hindsight, Applicant respectfully submits that the rejection is improper.

Withdrawal of the rejection is respectfully requested.

With respect to the rejection of claims 46 and 65 under 35 U.S.C. §103(a) over Kubacki et al. in view of Carlson and further in view of Kwon, U.S. Patent No. 6,160,835, Applicant has the following remarks.

The Office Action relies on Kwon to teach a preferred method of laser engraving using a laser beam in the near IR wavelength range for marking metal. This does not make up for the deficiencies noted above with respect to Kubacki and Carlson. Therefore, claim 46 is allowable by virtue of its dependence on claim 44, and claim 65 is allowable by virtue of its dependence on claim 63. Moreover, Kwon does not teach or suggest using a laser beam in the near IR wavelength range for marking cans. There is no motivation for "picking" and "choosing" among the various elements of Carlson/Kubacki/Kwon, to the exclusion of other elements, to arrive at the claimed combination. See In re Kamm, 172 USPQ 298, 301, 302 (CCPA 1972) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art"). Withdrawal of this rejection is respectfully requested.

With respect to the rejection of claims 47-55 and 66-73 under 35 U.S.C. §103(a) over Kubacki et al. in view of Carlson, further in view if Kwon, and further in view of Kobsa, U.S. Patent No. 6,163,010, Applicant has the following remarks.

The Office Action relies on Kobsa to teach a diode laser pumped Nd:YAG laser. This does not make up for the deficiencies noted above with respect to Kubacki, Carlson and Kwon. As a result, claims 47-55 are allowable by virtue of their dependence on claim 44, and claims 66-73 are allowable by virtue of their dependence on claim 63. Moreover, Kobsa does not teach or suggest using a diode laser pumped Nd:YAG laser for marking cans. In contrast, Kobsa discloses laser cutting a manufactured object. There is no motivation for "picking" and "choosing" among the various elements of Carlson/Kubacki/Kwon/Kobsa, to the exclusion of other elements, to arrive at the claimed combination. See In re Kamm, 172 USPQ 298, 301, 302 (CCPA 1972) ("It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given

position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art"). Withdrawal of this rejection is respectfully requested.

Applicant appreciates the indication of allowable subject matter in claims 58-60 and 77-79. However, in view of the above amendments and remarks, Applicant respectfully submits that all the claims are patentable and that the entire application is in condition for allowance.

New claims 92-96 have been added. Entry and allowance of these new claims are respectfully requested.

Further, we filed the July 17, 2001 Information Disclosure Statement after the issuance of the current Final Office Action and did not authorize charging our Deposit Account. By this Preliminary Amendment, we authorize charging the petition fee to our Deposit Account No. 03-3975 under Order No. 9521/256642, if necessary. Please proceed to consider the Information Disclosure Statement and return an initialed copy of the PTO-1449 with the next Office Action.

In regards to the possible interference with U.S. Patent No. 6,080,958 to Miller et al., Applicant wishes to bring U.S. Patent Nos. 09/564,429, 09/690,278, and 09/690,282 to the Examiner's attention, which are continuing applications of the Miller patent.

Should there be any questions or concerns regarding this application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
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## APPENDIX

## VERSION WITH MARKINGS TO SHOW CHANGES MADE



**IN THE CLAIMS:**

The claims are amended as follows:

87. (Amended) A can end having an opening tab [as set forth in claim 83] fastened thereon, the opening tab having at least one laser engraved mark on at least one of a top surface and a bottom surface thereof.

88. (Amended) A can having a can end with an opening tab [as set forth in claim 83] fastened thereon, the opening tab having at least one laser engraved mark on at least one of a top surface and a bottom surface thereof,

wherein said at least one laser engraved mark is located on the bottom surface of said opening tab to form a code indicating that a person who opens the can using the tab is a winner.

New claims 92-96 have been added.